

**Amendments to the Drawings:**

The attached sheets of drawings include changes to Figs. 8 and 9. These sheets, which include Figs. 8 and 9, replace the original sheets including Figs. 8 and 9.

Attachment: Annotated Sheets  
Replacement Sheets

### **REMARKS/ARGUMENTS**

In view of the foregoing amendments and the following remarks, the applicant respectfully submits that the pending claims comply with 35 U.S.C. § 112, ¶ 2, are statutory under 35 U.S.C. § 101, and are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. **If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, the applicant respectfully requests that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits.**

The applicant will now address each of the issues raised in the outstanding Office Action.

#### **Objections**

##### ***Drawings***

The drawings are objected to as failing to comply with 37 C.F.R. § 1.84 (p) (4). Specifically, the Examiner noted that reference character "3" is used inconsistently in Figures 1, 8 and 9. Replacement sheets for Figures 8 and 9, which avoid the inconsistent use of reference character "3", are filed herewith.

##### ***Claims***

Claims 1-3 and 5 are objected to due to minor errors, typically because certain terms might lack proper antecedent basis. The claims have been amended, based on

the Examiner's helpful suggestions, to correct such informalities.

Further, the Examiner notes that claims 2 and 3 refer to a supplier, which appears to correspond to the manufacturer, not the retailer, in the drawings. The applicants respectfully note that a "supplier" can be one of various parties, depending on whether the supplier is with respect to wholesalers, retailers, or customers. Thus, a supplier is not necessarily a manufacturer or a retailer. According, the applicant submits that these claims should not be objected to.

Furthermore, the Examiner notes that the acts of recording information on a recording medium and transmitting it by sending the medium from the buyer to the seller does not further limit claims 1 and 2 since claim 2 includes a step for transmitting the information via a telecommunications line. Claim 3, as amended, depends from claim 1 rather than claim 2. Accordingly, the applicant submits that these claims should not be objected to.

#### **Rejections under 35 U.S.C. § 112**

Claims 1-5 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner believes that claims 1 and 4 are indefinite. The claims, as amended, more particularly point out and distinctly claim the invention. According, this ground of rejection should be withdrawn.

**Rejections under 35 U.S.C. § 101**

Claims 1-5 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The applicant respectfully requests that the Examiner reconsider and withdraw this ground of rejection in view of the following.

The Examiner contends that for the claimed invention to be statutory, it must be within (i.e., apply, involve, use, or advance) the technological arts, and that mere abstract ideas, laws of nature, or natural phenomena do not apply, involve, use or advance the technological arts. The Examiner concludes that although the claims recite technology, such technology is involved in a trivial manner, and interprets "program" broadly to include things other than computer executable instructions embedded on a tangible medium. The Examiner further concludes that the various steps in the claims can be performed using paper and pencil, and that the transmission can be performed using a postal network. The Examiner suggests amending the claims to better clarify which steps are being performed within the technological arts, such as by incorporating a computer network or an electronic network into the transmission step for example. (See Paper No. 20050118, pages 9 and 10.)

Claim 1 has been amended to clarify that the program includes computer executable instructions and is embedded in a tangible medium. Accordingly, claim 1, as amended, recites statutory subject matter for at least this reason. Since each of claims 2-5 depends, either directly or indirectly, from claim 1, these claims are

also statutory for at least this reason. In view of the foregoing, the Examiner should withdraw this ground of rejection.

### **Rejections under 35 U.S.C. § 103**

Claims 1-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,167,383 ("the Henson patent") in view of U.S. Patent No. 6,836,617 ("the Parulski patent"). The applicant respectfully requests that the Examiner reconsider and withdraw this ground of rejection in view of the following.

Before addressing at least some of the patentable features of the claimed invention, the applicant will introduce the Henson and Parulski patents. The Henson patent discusses a method of ordering a computer system on a web-based online store. According to the Henson patent, in an online store, a user selects a desired part or parts, and orders a computer system having a desired configuration. The Parulski patent discusses a method in which a purchaser accesses a data base through a communication line to configure a film product having a desired specification, and the product is sent to the purchaser.

As can be appreciated from the foregoing, the Henson and Parulski patents, like the present invention, each concern enabling a customer (e.g., a purchaser) to obtain a product having a desired configuration and a desired specification. However, unlike the present invention, both the Henson and Parulski patents help a customer to obtain a desired product **when ordering** the product, **not**

**after** the product has been **purchased or received**.

Specifically, claim 1, as amended, recites an act of:

accepting, from a buyer **who has received the product**, specifications modifying information for use in modifying the a product on the basis of an information preparation program, including computer executable instructions and embedded on a tangible medium, **made available to the buyer after purchasing the product**... . [Emphasis added.]

To summarize, the methods of the Henson and Parulski patents can be used to help a customer to obtain a desired product **when ordering the product**. On the other hand, the present invention enables a customer to customize a desired product **after obtaining it** (e.g., after purchasing it).

The ability to allow a customer to customize a produce after obtaining (e.g., purchasing it) has a number of advantages. For example, as is often the case, a customer does not have a clearly defined desired configuration or specification in mind when ordering a product. However, it may be assumed that a large majority of customers will be satisfied with a product having an average specification and configuration. Such customers would not wish to execute a complicated order process, such as those espoused in the Henson and Parulski patents for example, when ordering a product. This is because since such customers would be satisfied with a product having a standard configuration, they would derive no benefit from interacting with such a complicating ordering process.

Embodiments consistent with the claimed invention allow such customers to avoid a complicated ordering process on the one hand, while on the other hand allowing some customers, who would not be satisfied by a product having an average configuration or specification, to customize their product. In view of such circumstances, in at least some embodiments consistent with the present invention, a specifications modifying program is supplied along with a product to a customer. This program permits the customer to customize the product after purchasing it. This method satisfies various types of customers, namely, (i) those that are happy with a product having as standard configuration (and therefore would gain not benefit from interacting with a complicated pre-purchase, customization process), and (ii) those that will want to customize the product, including those that may wish to customize the product after getting acquainted with it. Thus, embodiments consistent with the present invention can satisfy more different types of customers than the methods espoused by the Henson and Parulski patents.

In at least some embodiments consistent with the claimed invention, after the program is executed by the customer, the product, along with customization information, is sent to the manufacturer (or some other party) and customized.

As can be appreciated from the foregoing, independent claim 1, as amended, is not rendered obvious by the Henson and Parulski patents. Since claims 2-5 depend, either directly or indirectly, from claim 1, these claims are similarly not rendered obvious by the Henson and Parulski patents.

The Examiner concedes that the Henson patent does not specifically refer to a program made available to a buyer by buying a product. However, the Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to make such a program available to a consumer at any time because customers like to comparison shop. (See Paper No. 20050118, page 11.) The applicant respectfully disagrees for a number of reasons.

First, the fact that customers like to comparison shop would lead one skilled in the art to make a product specification customization program available to consumers pre-purchase (before the product is received), not post-purchase (after the product is received). Thus, the desirability of comparison shopping would lead one skilled in the art away from the modification proposed by the Examiner.

Second, the Henson patent concerns computers. Given the complexity of computers, the various needs of computer users, and the physical size and weight (and therefore the expense of shipping computers to and from customers), one skilled in the art would not have been motivated to modify the Henson patent as proposed by the Examiner.

Third, since the Examiner provides no suggestion in the prior art for making the proposed modification of the Henson patent, one can only assume that it is the product of impermissible hindsight. If the Examiner maintains this ground of rejection, the applicant respectfully submits that he must show some suggestion in the prior art to make the modification proposed.



Further regarding dependent claim 5, the Examiner concedes that the Henson patent does not teach customer modification of specifications for (a) painting and printing an outer surface of a camera, (b) a profile of a camera, and (c) an operating control program of a camera. To compensate for this admitted deficiency, the Examiner both (1) relies on the Parulski patent as teaching customizing electronic products, such as cameras, according to a customers demand, (2) concludes that it would have been obvious the combine the purported teaching of the Parulski patent with the Henson patent, as modified, and (3) concludes that it would have further been obvious to permit the specific modifications claimed. (See Paper No. 20050118, page 13.) However, even assuming, arguendo, that one skilled in the art would have been motivated to modify the Henson patent in view of the purported teachings of the Parulski patent, the resulting method would not compensate for the deficiencies of the Henson patent with respect to claim 1, discussed above. That is, like the Henson patent, the Parulski patent concerns helping a customer to obtain a desired product ***when ordering the product, not after obtaining it.*** Thus, claim 5 is not rendered obvious by the Henson and Parulski patents for at least this reason.

#### **New claims**

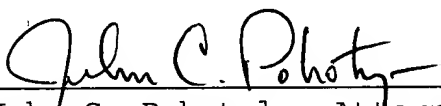
New claims 14-18 are allowable over the Henson and Parulski patents for at least the reasons discussed above with respect to claim 1.

**Conclusion**

In view of the foregoing amendments and remarks, the applicant respectfully submits that the pending claims are in condition for allowance. Accordingly, the applicants request that the Examiner pass this application to issue.

Respectfully submitted,

May 26, 2005

  
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**CERTIFICATE OF MAILING under 37 C.F.R. 1.8(a)**

I hereby certify that this correspondence is being deposited on **May 26, 2005** with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

  
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John C. Pokotylo

36,242  
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ANNOTATED SHEET

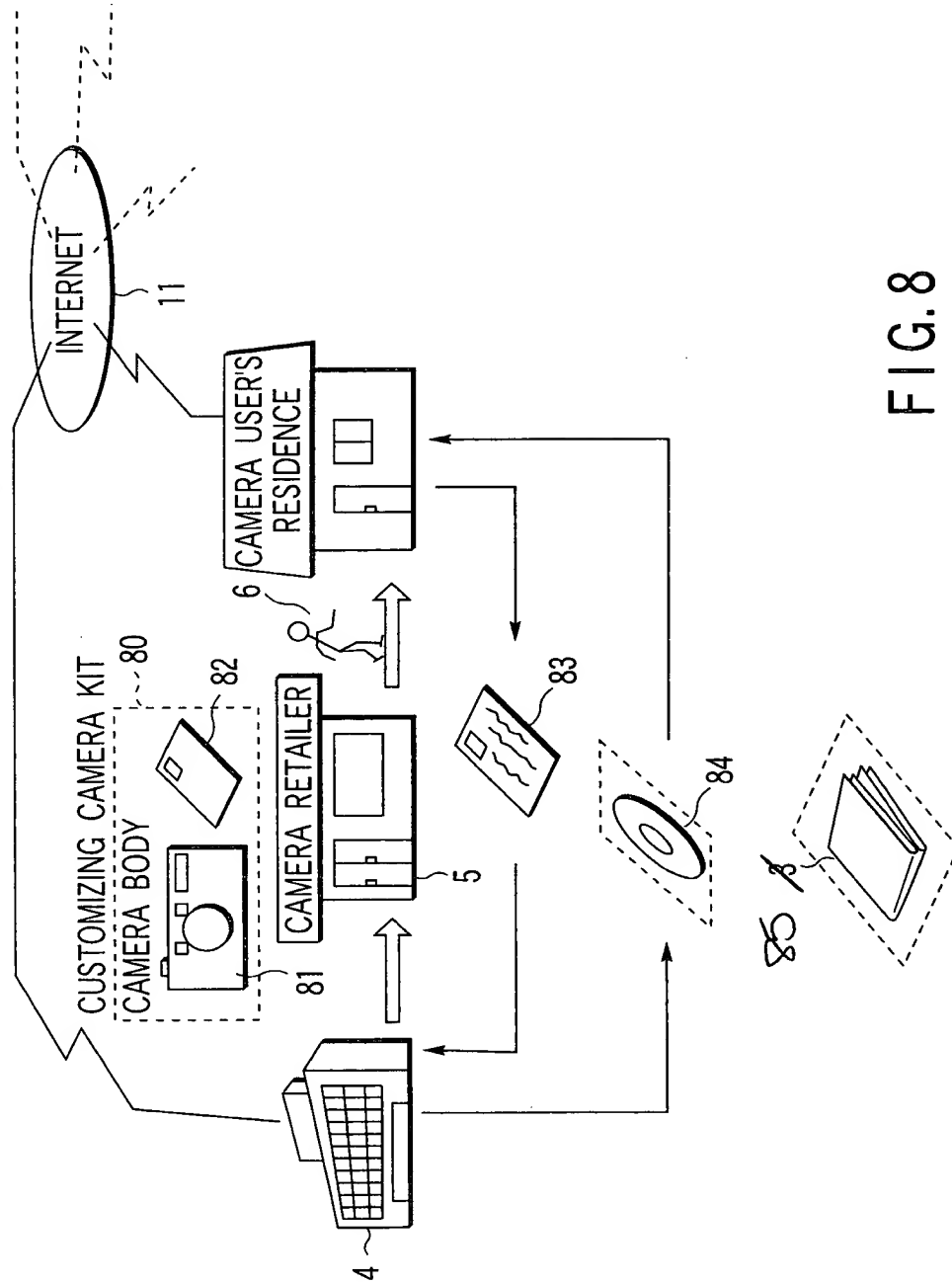


FIG. 8

ANNOTATED SHEET

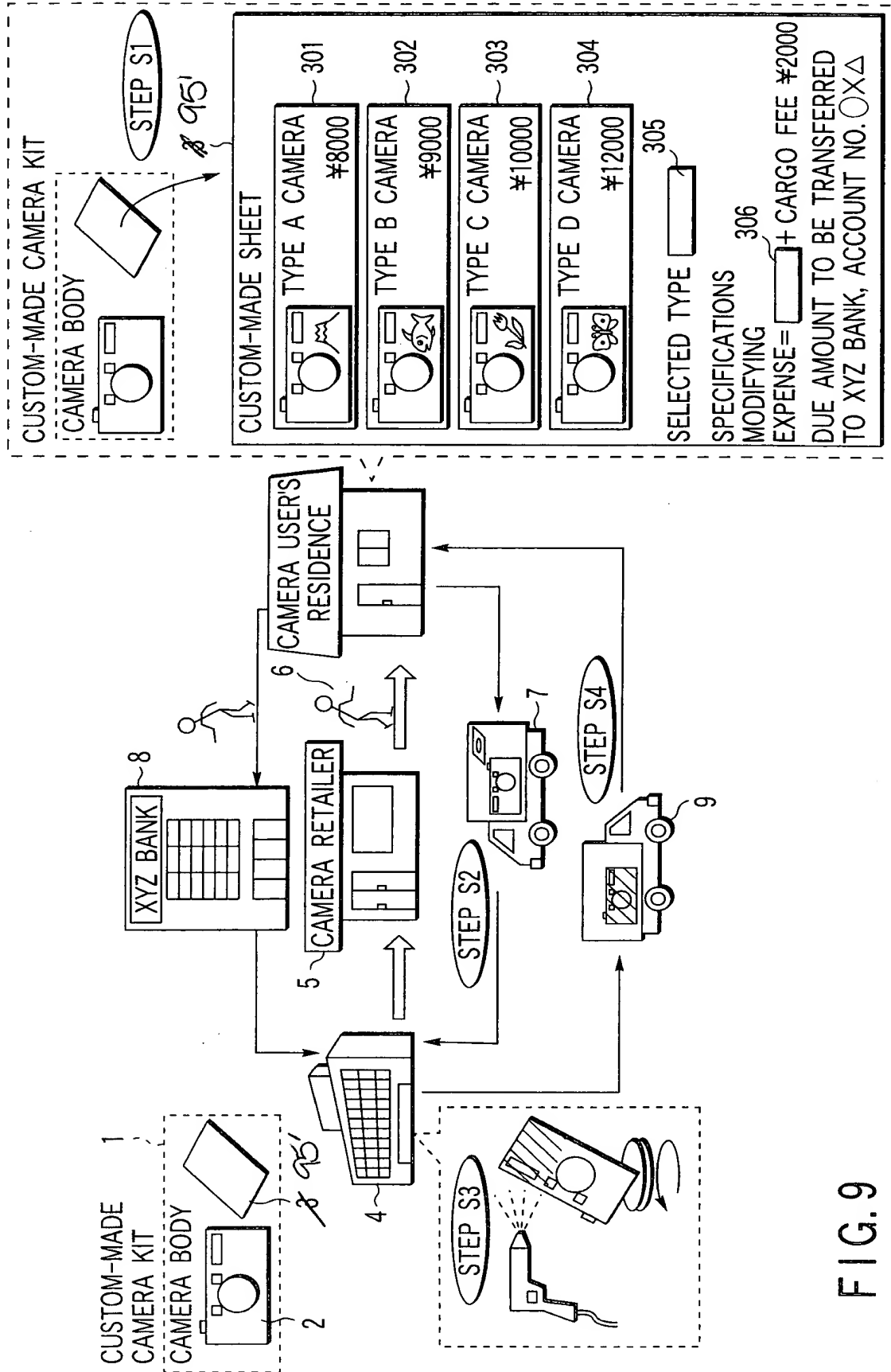


FIG. 9